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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,580	06/20/2001	Naohiko Moriyama	AAO-255	1490

7590 09/21/2005

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EXAMINER

CHORBAJI, MONZER R

ART UNIT PAPER NUMBER

1744

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/868,580	<b>Applicant(s)</b> MORIYAMA ET AL.	
	<b>Examiner</b> MONZER R. CHORBAJI	<b>Art Unit</b> 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 and 19 is/are allowed.
- 6) ☒ Claim(s) 14-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/01/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

**This final action is in response to the amendment received on 07/01/2005**

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1744

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gacki et al (U.S.P.N. 4,197,942).

With respect to claim 14, the Gacki reference, which is in the art of mixing prepackaged vessels with water, teaches a cylindrical cutter (figure 4b, 88) having a cutting edge (figure 4a, 95A and col.10, lines 58-59) along the inclined end (the inclined end in figure 4a being the entire edge including 95b) such that the inclined end having a top (unlabeled top of cutter 88 in figure 4a) that makes first contacts with the membrane (col.10, lines 40-43). The cylindrical cutter includes a slit (figure 4b, 92) extending from the bottom of the inclined end into the cutter body. Further, the Gacki reference teaches that the cylindrical cutter is constructed by rolling a flat sheet (col.11, lines 8-11) such that a rolled flat sheet results in a hollow cylindrical cutter. With respect to the added feature that the slit extends from the top of the inclined end, the disclosure does not provide any advantages for such a structural design. Thus, absence from any advantages, making the slit extends from the top of the inclined end into the cutter body versus the slit extending from the bottom of the inclined slit as taught by the Gacki reference is a matter of choice of design.

5. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gacki et al (U.S.P.N. 4,197,942) as applied to claim 14 and further in view of Bernstein et al (U.S.P.N. 5,366,114).

With respect to claim 15, the Gacki reference fails to teach a cutter with a serrated portion along the inclined end. The Bernstein reference, which is in the art of dispensing, sealed containers by piercing through a frangible membrane, teaches the

Art Unit: 1744

use of a cutter with a serrated edge (figure 5, 44 and 54). As a result, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cutter of the Gacki reference by including a serrated portion as taught by the Bernstein reference since a cutter with a partial serrated edge prevents the membrane from falling into the liquid by keeping a portion of the membrane in connection with uncut portion (col.3, lines 63-67).

With regard to claims 16-18, the Gacki reference fails to teach a cutter with a serrated portion along the inclined end. The Bernstein reference, which is in the art of dispensing, sealed containers by piercing through a frangible membrane, teaches the use of a cutter with a partial serrated edge (figure 5, 44, 54 and 56). The Bernstein reference teaches that the non-serrated portion (figure 5, 56) maintains the membrane in connection with the uncut portion after piercing the frangible membrane (col.3, lines 63-67). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cutter of the Gacki reference by including a partial serrated portion as taught by the Bernstein reference since determining the portion of the serrated edge of the cutter depends on the liquid dispensing rate.

**6.** Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gacki et al (U.S.P.N. 4,197,942) in view of Bernstein et al (U.S.P.N. 5,366,114) as applied to claim 15 and further in view of Taylor (U.S.P.N. 3,581,605).

With regard to claim 18, the Gacki reference fails to teach a cutter with a serrated portion provided along the inclined end. The Bernstein reference, which is in the art of dispensing, sealed containers by piercing through a frangible membrane, teaches the

Art Unit: 1744

use of a cutter with a partial serrated edge (figure 5, 44, 54 and 56), but fails to teach a cutter with serrations all around the edge. The Taylor reference, which is in the art of dispensing, pre-filled and sealed containers, teaches a cutter with serrations all around the edge (figure 1, 9). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cutter of the Gacki reference by including serrations all around the edge of the cutter as taught by the Taylor reference in order to insure complete severance of the membrane from the container neck (col.3, lines 35-39).

#### ***Allowable Subject Matter***

7. Claims 1-13 and 19 are allowed. Instant independent claims 1, 10 and 19 recite the feature that a mechanism for vertically moving the holder toward the cutter that is stationary. The closes prior art, The Treu et al ('099) reference and the Gacki et al ('942) reference both teach the opposite which is a moving the cutter toward a stationary holder such that it is not obvious in view of the found prior art to switch this mechanism.

#### ***Remarks***

8. The IDS submitted on 06/01/2005 contains the NPL document, cited, as "Japanese Office Action mailed April 26, 2005". This document was not considered since it is written completely in Japanese and no English translation was provided. The document has been sent for English translation.

#### ***Response to Arguments***

9. Applicant's arguments filed on 07/01/2005 have been fully considered but they are not persuasive.

On page 8 of the Remarks section, applicant argues that, "However, the slit is provided at a location other than the tip end of the cutter. If the cover film is cut by such a cutter as disclosed by Gacki et al., the circular cut trace of the sealing film may be that shown in illustration C. Therefore, the cut piece of the film may become completely detached from the original film." The examiner disagrees. The Gacki reference teaches that part of the circular cut trace of the sealing film remains (col.11, lines 8-15) because of slit, 92, as shown in figure 4b, 92. Thus, the slit of the Gacki reference results in preventing the complete cut of the septum and the septum remains attached throughout the procedure. In addition, on where does the disclosure provide any advantages for having the slit extends from the top of the inclined end. Thus, absence from any advantages, making the slit extends from the top of the inclined end into the cutter body versus the slit extending from the bottom of the inclined slit as taught by the Gacki reference is a matter of choice of design.

On pages 8-9 of the Remarks section, applicant argues that, "Bernstein et al. and Taylor et al. only teach cutters with a serrated edge and do not teach or suggest at all a cutter body substantially in the form of a hollow cylinder having an inclined end provided with a top thereof which first contacts with the membrane and a slit extending from the top of the inclined end into the cutter body." The examiner agrees that the Bernstein and the Taylor references teach cutters with a serrated edge since this is the reason both references are applied; however, as explained above with respect to a hollow cylindrical

Art Unit: 1744

cutter body having an inclined end with a top and a slit extending from the bottom of the inclined end into the cutter body, such limitations are taught by the Gacki reference.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MONZER R. CHORBAJI** whose telephone number is (571) 272-1271. The examiner can normally be reached on M-F 6:30-3:00.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **JOHN KIM** can be reached on (571) 272-1142. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1744

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Monzer R. Chorbaji *MRC*  
Patent Examiner  
AU 1744  
09/09/2005

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**SUPERVISORY PATENT EXAMINER**